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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/317,069 | 05/13/1999 | SHIGETAKA TANAKA | 2271/59262 | 8608 |
| 7590 02/09/2006 COOPER & DUNHAM LLP 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10038 | | | EXAMINER POKRZYWA, JOSEPH R | |
| | | | ART UNIT 2622 | PAPER NUMBER |

DATE MAILED: 02/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|---------------------------------------|--|--|
| Office Action Summary | Application No. 09/317,069 | Applicant(s) TANAKA, SHIGETAKA | |
| | Examiner Joseph R. Pokrzywa | Art Unit 2622 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 and 11 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 10/31/05, and has been entered and made of record. Currently, **claims 1-11** are pending.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-3 and 5-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Kanaya (U.S. Patent Number 6,137,597)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding *claim 1*, Kanaya discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 3, line

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60-column 4, line 9, and column 6, lines 11-38) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (see Fig. 5, column 6, line 24-column 7, line 5), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 9, lines 10-45), wherein the identification information of the calling facsimile machine identifies the calling facsimile machine (column 6, lines 39-55, and column 9, lines 10-28), comparing the identification information of the calling facsimile machine with the identification information prestored in the memory (column 9, line 46-column 10, line 20), canceling performance of the facsimile communications operation using the optional frame and executing standard facsimile operations that do not use the optional frame (“no” in step 107 or “no” in step 116 of Fig. 11), when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 9, line 33-column 10, line 4, and column 11, lines 16-45), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 10, lines 5-47, and column 11, lines 16-45).

Regarding *claim 2*, Kanaya discloses the method discussed above in claim 1, and further teaches that the identification information prestored in the memory comprises subscriber identifications each contained in a frame TSI to be generated by each of the plurality of different facsimile machines and the identification information received in the receiving step is a

subscriber identification contained in a frame TSI generated by the calling facsimile machine (column 6, lines 30-67, and column 8, line 49-column 9, line 22).

Regarding *claim 3*, Kanaya discloses the method discussed above in claim 1, and further teaches that the optional frames include SUB, SEP, and PWD in conformance with the recommendation T-30 of ITU-T (column 6, lines 23-67, and column 8, line 49-column 9, line 22).

Regarding *claim 5*, Kanaya discloses a facsimile apparatus (see Fig. 2) comprising memory means for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (see Fig. 5, column 6, line 24-column 7, line 5), modem means (modem 10) for receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 5, lines 1-7, and column 9, lines 10-45), and a controller means for (a) verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 9, line 46-column 10, line 20), (b) canceling performance of the facsimile communications operation using the optional frame and executing standard facsimile operations that do not use the optional frame ("no" in step 107 or "no" in step 116 of Fig. 11), when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 9, line 33-column 10, line 4, and column 11, lines 16-45), and (c) executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 10, lines 5-47, and column 11, lines 16-45), wherein the

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identification information of the calling facsimile machine identifies the calling facsimile machine (column 6, lines 30-67).

Regarding **claim 6**, Kanaya discloses a facsimile apparatus (see Fig. 2) comprising memory for prestoring identification information for a plurality of different facsimile machines having common specifications of optional frames (see Fig. 5, column 6, line 24-column 7, line 5), a modem (modem 10) for receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 5, lines 1-7, and column 9, lines 10-45), and a controller for (a) verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 9, line 46-column 10, line 20), (b) canceling performance of the facsimile communications operation using the optional frame and executing standard facsimile operations that do not use the optional frame (“no” in step 107 or “no” in step 116 of Fig. 11), when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 9, line 33-column 10, line 4, and column 11, lines 16-45), and (c) executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 10, lines 5-47, and column 11, lines 16-45), wherein the identification information of the calling facsimile machine identifies the calling facsimile machine (column 6, lines 30-67).

Regarding **claim 7**, Kanaya discloses a facsimile communication method for performing a Group 3 facsimile communications operation using an optional frame signal (column 3, line 60-column 4, line 9, and column 6, lines 11-38) comprising providing a facsimile apparatus with

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a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (see Fig. 5, column 6, line 24-column 7, line 5), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 9, lines 10-45), verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 9, line 46-column 10, line 20), wherein the identification information of the calling facsimile machine identifies the calling facsimile machine (column 6, lines 39-55, and column 9, lines 10-28), and wherein when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory, standard facsimile operations that do not use the optional frame are performed while facsimile operations that would use the optional frame are cancelled (column 9, line 33-column 10, line 4, and column 11, lines 16-45).

Regarding *claim 8*, Kanaya discloses the apparatus discussed above in claim 5, and further teaches that the memory means stores a table of identification information identifying facsimile machines capable of operating with optional frames (see Fig. 5, column 6, line 24-column 7, line 5).

Regarding *claim 9*, Kanaya discloses the apparatus discussed above in claim 6, and further teaches that the memory stores a table of identification information identifying facsimile machines capable of operating with optional frames (see Fig. 5, column 6, line 24-column 7, line 5).

Regarding *claim 10*, Kanaya discloses a method for performing a facsimile communications operation using an optional frame signal (column 3, line 60-column 4, line 9, and column 6, lines 11-38) comprising providing a facsimile apparatus with a memory which prestores identification information for a plurality of different facsimile machines having common specifications of optional frames (see Fig. 5, column 6, line 24-column 7, line 5), receiving a call from a calling facsimile machine for a facsimile communications operation using an optional frame and identification information of the calling facsimile machine (column 9, lines 10-45), verifying the identification information of the calling facsimile machine with the identification information prestored in the memory (column 9, line 46-column 10, line 20), canceling performance of the facsimile communications operation using the optional frame and executing standard facsimile operations that do not use the optional frame (“no” in step 107 or “no” in step 116 of Fig. 11), when the identification information of the calling facsimile machine does not correspond with the identification information prestored in the memory (column 9, line 33-column 10, line 4, and column 11, lines 16-45), and executing the facsimile communications operation using the optional frame when the identification information of the calling facsimile machine corresponds to the identification information prestored in the memory (column 10, lines 5-47, and column 11, lines 16-45), wherein the identification information of the calling facsimile machine identifies the calling facsimile machine (column 6, lines 30-67).

Allowable Subject Matter

4. **Claims 4 and 11** are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

Regarding ***claims 4 and 11***, in the examiner's opinion, it would not have been obvious at the time the invention was made to have the invention, as claimed, include the features of performing a Group 3 facsimile operation using optional frame signals in a calling number display service mode, whereby the system verifies the telephone number received in the calling number display service mode, and when the telephone numbers do not correspond, cancels performance of the facsimile operation using the optional frame and executing standard facsimile operations that do not use the optional frame.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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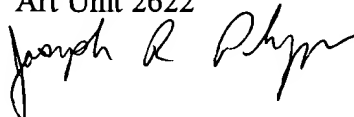
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrp